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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,818	01/28/2000	Mark Alperovich	109289.00121	2697

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EXAMINER

ANGEBRANNDT, MARTIN J

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 01/10/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-7

Office Action Summary	Applicati n No.	Applicant(s)	
	09/493,818	ALPEROVICH ET AL.	
	Examiner	Art Unit	
	Martin J Angebrannt	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 August 2001 and 05 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: |

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1 The response provided by the applicant has been read and given careful consideration. Responses to the arguments offered by the applicant are presented after the first rejection to which they are directed. The rejection over co pending Application No. 09/493267 is withdrawn based upon the lack of a recitation of a primer layer in that application.

2 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3 Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide a basis for “co-polymers” of “polyvinyl chloride” or “chlorinated polyvinyl chloride” as the film forming polymer. (see page 5/line 17 of spec.)

4 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5 Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, “chlorinated polyvinyl chloride” does not make any sense as it is already chlorinated.

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In claim 15, "butyl glycol" and "diethyl glycol" are not chemical names (ie. not specific compounds) and should be replaced in the claims and specification (page 6/lines 1-2) with - - butylene glycol - - and -- diethylene glycol--, respectively. (noting propylene glycol recitation)

In claim 15, "dimethyl glycol" is not a chemical name (ie. not a specific compound). There is no obvious choice with respect to a similar compound when considering a possible typographical error. (see The Merck Index , copy provided)

6 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7 Claims 11,12,14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792.

Tamura et al. '792 teaches optical recording media such as example 1-18 which mixes a cyanine dye (201) with a polymethine coloring agent coated on a polycarbonate substrate and dried. (1-1 is at column 28 and 1-18 is at column 31) The addition of other dyes, such as cyanine, phthalocyanine, xanthene dyes and stabilizers to the recording layer is disclosed. (25/15-26/26) The use of binders, including nitrocellulose is disclosed. (26/61-65) The addition of plasticizers, surface active agents and the like to improve the film forming properties and stability of the coated film is disclosed. The examiner notes that the dispersants are surfactants (26/66-27/5) The use of various coating methods is disclosed. (27/12-23). The drying of the recording medium is disclosed in the examples. The use of underlayers between the support and the recording layer to

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protect the substrate from coating solvents and increase adhesion of the recording layer is disclosed. These may be 5-100 nm in thickness. The use of various resins is disclosed, including UV curing resins, thermosetting resins, vinyl resins, silicones, silica (silicon dioxide), liquid rubber (latexes) and thermoplastic resins. (27/30-53) Useful coating solvents are disclosed. (26-48) Useful substrates are also disclosed. (25/12-14). The formation of a air sandwich structure where two media are bonded together with an air gap or alternatively bonded directly to each other via a protective layers is disclosed. (27/66-28/7)

It would have been obvious to add a binder, a plasticizer and a stabilizer to the composition of example 1-18 of Tamura et al. '792 based upon the disclosure that these are desirable additives to the recording layer and to use a primer such as a thermosetting resin to increase the adhesion and the resistance of the substrate to damage from the coating solvents based upon the direction to do so. Additionally, it would have been obvious to form a dual recording layer media, using the air sandwich or bonded directly together via their protective layer to double recording capacity of a single medium.

The applicant argues intended use. The examiner notes that the claims are tot he article or methods of making it. The issue of how it is used is not relevant to the claims at hand unless it was impossible to use them in the manner described. This is clearly not the case. The rejection stands.

8 Claims 11-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792, in view of Sasakawa et al. '094.

Sasakawa et al. '094 teaches the coating of optical recording media where the drying includes heating up to 100 degrees C. (8/1-3) Useful solvents are disclosed. (4/20-6/25). The use of polyvinyl chloride resins as substrate materials is disclosed. (3/7-12).

In addition to the basis provide above, the examiner holds that it would have been obvious to modify the process of Tamura et al. '792, by drying at 100 degrees C based upon the direction within Sasakawa et al. '094 that this is known in the art and produces useful optical recording media with a reasonable expectation of success.

The rejection stands for the reasons provided above without further response as no additional arguments were directed at this rejection.

9 Claims 11-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura et al. '792, in view of Sasakawa et al. '094 and further in view of Sato et al. '554.

Sato et al. '554 teaches with respect to example 8 in column 10 a recording medium formed from a cyanine dye and a plasticizer coated from a solvent. Useful plasticizers are disclosed (5/10-44). The addition of antioxidants, such as nickel complexes is disclosed. (3/31-35). The addition of a binder is disclosed (3/27-35 and 3/57-4/10) and these may be selected from materials disclosed as useful in forming the protective layer, including polyvinyl chloride. (3/27-31 and 3/57-4/8). The use of an undercoat layer is also disclosed. (7/8) Useful substrates are also disclosed, including polycarbonate, polyvinyl chloride and polyethylene resins. (2/4-15) Other useful dyes, including phthalocyanine dyes are disclosed. (2/39-46)

In addition to the basis provided above, it would have been obvious to use other binders disclosed as useful, such as polyvinyl chloride as taught by Sato et al. '554, based upon the disclosure of equivalent function.

The rejection stands for the reasons provided above without further response as no additional arguments were directed at this rejection.

1. 10Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Angebrannndt whose telephone number is (703) 308-4397.

I am normally available between 7:30 AM and 5:00 PM, Monday through Thursday and 7:30 AM and 4:00 PM on alternate Fridays.

If repeated attempts to reach me are unsuccessful, my supervisor may be reached at (703) 308-2464.

Facsimile correspondence should be directed to (703) 3872-9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Martin J. Angebrannndt
Primary Examiner, Group 1750
January 9, 2002